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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,190	08/02/2006	Nikolai (Mykola) Ignatyev	MERCK-3196	6775

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EXAMINER
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DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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12/20/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/588,190

Applicant(s)

IGNATYEV ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: the parentage should appear immediately after the title (or on an Application Data Sheet). MPEP 1893.03(c). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is insufficient antecedent basis for limitations with respect to counteranion A<sup>-</sup>, for instance, [PF<sub>6</sub>]<sup>-</sup> or [BF<sub>4</sub>]<sup>-</sup>. There is also insufficient antecedent basis for [CF<sub>3</sub>SO<sub>3</sub>]<sup>-</sup> (which had been excluded by proviso from independent claim 16).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 16 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 4,673,632. The reference teaches applicant's compound: column 5, compound 3.

Claim 17 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 4,673,632. The reference teaches applicant's compounds: column 7, compound 18; column 8, compounds 31-33 and 35; column 9, compounds 36-38.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 6,222,046 B1. The reference teaches applicant's compounds: column 8 (beginning), claims 1-3.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Organic Magnetic Resonance* (1975), 7(3), p.128-136 (CAPLUS abstract). The reference teaches applicant's compound: RN=56638-27-8.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Pept. Chem. 1992, Proc. Jpn. Symp.*, 2nd (1993), meeting date 1992, p. 51-53 (CAPLUS abstract). The reference teaches applicant's compounds: RN=101385-69-7; 153433-26-2.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,712,418 (CAPLUS abstract). The reference teaches applicant's compound: RN=164298-27-5.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Journal of Organic Chemistry* (1999), 64(19), p.6989-6992 (CAPLUS abstract). The reference teaches applicant's compound: RN=242130-50-3.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 2002260966 (CAPLUS abstract). The reference teaches applicant's compounds: RN=457897-61-9; 457897-62-0; 457897-64-2.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by PL 170331 (CAPLUS abstract). The reference teaches applicant's compound: RN=188748-95-0.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by ES 2181554 (CAPLUS abstract). The reference teaches applicant's compounds: RN=457897-64-2; 463932-90-3.

#### ***Allowable Subject Matter***

Claims 1-15 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art appears to be *Journal of Fluorine Chemistry* (2000), 103(2), p. 159-161, which teaches a related process (page 160, Scheme 1). The prior art process neither teaches nor suggests the instant process.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached at 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
December 12, 2007